

Remarks

Claims 1-18 are now pending in the case.

I. Rejection of Claims 1-10 under 35 U.S.C. 103(a) based on Chou in view of Schwartz

Claims 1-10 have been rejected under 35 U.S.C. 103(a) based on Chou in view of Schwartz. These rejections are respectfully traversed.

Claim 1 of the present application specifies:

1. An apparatus comprising:
a left end piece;
a right end piece; and
a pillow;
wherein the left end piece has a recess into which a left portion of the pillow can be inserted;
wherein the right end piece has a recess into which a right portion of the pillow can be inserted;
and wherein the pillow is substantially softer than the left end piece and the right end piece.

Claim 1 specifically requires that the pillow be substantially softer than the left end piece and the right end piece. Chou does not disclose providing a pillow that is substantially softer than a left end piece and a right end piece. In the examiner's second office action (Office action of 1/12/05), the examiner, referring to Chou states that:

"... wherein the user can adjust the hardness and softness of the pillow pieces (col. 1, Ins. 30-34) (col. 2, lines 25-28 and 38-40) therefore a user is clearly capable of adjusting one piece to be substantially softer than the left end piece and the right end piece through the selection of different materials." (emphasis added, Examiner's office action, 1/12/05, pg. 2)

Respectfully, the examiner's rejection and rationale are incorrect as a matter of law. It doesn't matter whether a user "can" adjust or is "capable" of adjusting the hardness and softness, the question is whether Chou specifically suggests providing a pillow that is substantially softer

than left and right end pieces as claimed in claim 1 of the present application. Chou does not provide any suggestion of having a pillow that is substantially softer than left and right end pieces.

As the Federal Circuit stated in In re Mills, while reversing the Patent Board of Appeals:

"While Mathis' apparatus may be capable of being modified to run the way Mills' apparatus is claimed, there must be a suggestion or motivation in the reference to do so." (emphasis added, In re Mills, 916 F.2d 680, at 682, Fed. Circ. 1990).

Also, with regards to claim 1, the examiner concedes that "Chou fails to disclose a recess in the left and right end pieces" however the examiner incorrectly concludes that:

"It would have been obvious to one having ordinary skill in the art at the time of the invention to employ the recess as taught by Schwartz in order to prevent lateral outward movement of the pillow pieces of Chou". (Examiner's office action, 1/12/05, p. 2).

The examiner is incorrect on this point, because the interior of the bag body 1 in Chou is provided with one or more chambers 13 physically set apart by one or more partitioning pieces 12. (Chou, col. 2, ln. 60- col. 1, ln. 67). As such, Chou already has a device, i.e. chambers 13 and/or partitioning pieces 12, which prevents lateral outward movement of plurality of pieces 2. (Chou, Fig. 1, col. 2, ln. 60 – col. 1, ln. 67) Therefore there is no reason or suggestion to employ the recesses of Schwartz to Chou, and furthermore it is unclear how the recesses would be employed.

Claim 1 is submitted to be allowable for at least the foregoing reasons. Claims 2-5 and 11-14 are dependent on claim 1 and are also submitted to be allowable for at least the foregoing reasons. Claims 11-14 were also indicated to be allowable if made independent, but have not been made independent in light of the assertion that claim 1 is allowable.

Claim 6 specifies:

6. A method comprising the steps of
inserting a right portion of a pillow into a recess of a right end piece;
inserting a left portion of a pillow into a recess of a left end piece; and
wherein the pillow is substantially softer than the left end piece and the right end piece.

Claim 6 specifically requires that the pillow be substantially softer than the left end piece and the right end piece. Chou does not disclose providing a pillow that is substantially softer than a left end piece and a right end piece. As for claim 1, the examiner similarly states with regard to claim 6 and referring to Chou that:

"... wherein the user can adjust the hardness and softness of the pillow pieces (col. 1, lns. 30-34) (col. 2, lines 25-28 and 38-40) therefore a user is clearly capable of adjusting one piece to be substantially softer than the left end piece and the right end piece through the selection of different materials." (emphasis added, Examiner's office action, 1/12/05, pg. 3, last paragraph)

As previously asserted, respectfully, the examiner's rejection and rationale are incorrect as a matter of law. It doesn't matter whether a user "can" adjust or is "capable" of adjusting the hardness and softness, the question is whether Chou specifically suggests providing a pillow that is substantially softer than left and right end pieces as claimed in claim 6 of the present application. (See In re Mills, 916, F.2d 680, at 682, Fed. Cir. 1990). Chou does not provide any suggestion of having a pillow that is substantially softer than left and right end pieces.

Also, with regards to claim 6, the examiner concedes that "Chou fails to disclose a method of inserting a right portion of a pillow into a recess of a right end piece and inserting a left portion of a pillow into a recess of a left end piece." However the examiner incorrectly concludes that:

"It would have been obvious to one having ordinary skill in the art at the time of the invention to employ the recess as taught by Schwartz in order to prevent lateral outward movement of the pillow pieces of Chou". (Examiner's office action, 1/12/05, pg. 3, last paragraph – p. 4, first paragraph).

As previously argued for claim 1, the examiner is incorrect on this point, because the interior of the bag body 1 in Chou is provided with one or more chambers 13 physically set apart by one or more partitioning pieces 12. (Chou, col. 2, ln. 60- col. 1, ln. 67). As such, Chou already has a device, i.e. chambers 13 and/or partitioning pieces 12, which prevents lateral outward movement of plurality of pieces 2. (Chou, Fig. 1, col. 2, ln. 60 – col. 1, ln. 67) Therefore there is

no reason or suggestion to employ the recesses of Schwartz to Chou, and furthermore it is unclear how the recesses would be employed.

Claim 6 is submitted to be allowable for at least the foregoing reasons. Claims 7-10 and 15-18 are dependent on claim 6 and are also submitted to be allowable for at least the foregoing reasons. Claims 15-18 were also indicated to be allowable if made independent, but have not been made independent in light of the assertion that claim 6 is allowable.

II. Conclusion

Claims 1-18 are respectfully submitted to be in a condition for allowance. Favorable reconsideration of this application is respectfully requested.

Respectfully submitted,



Walter J. Tencza Jr.
Reg. No. 35,708
Suite 3
10 Station Place
Metuchen, N.J. 08840
(732) 549-3007
Fax (732) 549-8486